

**REMARKS**

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14 and 16-26 were rejected under 35 U.S.C. §103, on the basis of the Farrell patent (U.S. 6,873,426) in view of the Trovinger et al. patent (U.S. 6,708,967). Claims 3, 6, 9, 12 and 15 were rejected under 35 U.S.C. §103, on the basis of the Farrell and Trovinger patents, in further view of the Jeyachandran et al. patent (U.S. 6,567,176). For the reasons presented in Applicants' previous responses, and further discussed hereinafter, it is respectfully submitted that these reference do not suggest the claimed subject matter to a person of ordinary skill in the art, whether considered individually or in combination.

The claimed subject matter is directed to printing situations in which a print job requires finishing operations to be performed as part of the print job. Some of these finishing operations may be capable of being automatically performed by the built-in features of the printer itself. However, if others of the finishing operations are outside the capabilities of the printer, they are carried out by a finishing device that may require user interaction to complete the job.

Claim 1 recites, among other elements, a printing system having an on-line client, a print server and printer, and an off-line finishing device. The claim recites that the print server includes a first memory for storing specifications of the on-line printer *and of the off-line finishing device*, as well as information regarding options installed thereon. Claim 1 further recites that the printing system includes a sorter for separating finishing specifics included in a job ticket into those to be performed by the on-line printer and those to be performed by the off-line finishing device, "based on the information regarding the specifications and installed options that is stored in the first memory". The claimed printing system also includes a creating unit for

creating data for a finishing device job ticket that includes the finishing specifics separated by the sorter and assigned to the off-line finishing device. As a result of the information that is stored in the memory, the print server is able to create a finishing device job ticket that includes those functions that can be performed by the off-line finishing device. This feature avoids the creation of a ticket having functions that cannot be performed by the off-line finishing device.

In rejecting Claim 1, the Office Action asserts that the Farrell patent discloses a printing system comprising an on-line client, print server and printer, as well as an off-line finishing device. Office Action at page 8, last partial paragraph. However, the Office Action goes on to acknowledge that the Farrell patent "does not expressly disclose a printing system further comprising an off-line finishing device." Office Action at page 12. To this end, the Office Action notes that the Trovinger patent discloses an off-line finishing device, which receives papers and a job ticket from another device. The Office Action concludes that it would be obvious to modify the system of the Farrell patent, to include an off-line finishing device in view of the Trovinger patent. It is respectfully submitted that a logical combination of the disclosures of the Farrell and Trovinger patents, based upon what each fairly teaches to a person of ordinary skill in the art, would not result in the subject matter of claim 1.

More particularly, the Farrell patent does not disclose a printing system that stores information about an on-line printer and a distinct finishing device, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the Farrell patent stores information about finishing capabilities, it is only information

about the finishing element 18. As can be seen in Figure 2, this finishing element is part of the printer 16 itself. Thus, the Farrell patent only discloses that information relating to the automated finishing capabilities of the printer are stored.

In rejecting claim 1, the Office Action asserts that the Farrell patent discloses a printing system that includes a memory means for storing specifications of an on-line printer and of an off-line finishing device. As apparent support for this assertion, the Office Action refers to the Farrell patent at column 5, lines 11-22. In relevant part, this portion of the patent pertains to an operation that is described in the patent as "substitute finishing". Referring to column 4, lines 8-16, substitute finishing can be employed in those situations in which the finishing element 18 is incapable of providing the requested results. When the system controller determines that the desired finishing is unavailable, it can substitute alternate finishing instructions "which are compatible with the available finishing equipment". The referenced passage at column 5, lines 9-22, discloses that, when substitute finishing is selected, the system controller retrieves alternate finishing instructions "which are compatible with the finishing installed element 18." These instructions can reside in the finishing element 18 itself or within a memory in the system 10.

From this disclosure, it is apparent that alternate finishing instructions are those which pertain to the finishing element 18, which is a component of the printer 16. Referring to the flowchart of Figure 3, when the substitute finishing is selected at step 48, the alternate finishing instructions are retrieved and substituted for the desired finishing instructions, and the job is finished with these alternate finishing instructions, at step 54. Since steps 48-54 are performed automatically to finish the job without any user interaction, these operations necessarily occur within the printer

16. Thus, it can be appreciated that these alternate finishing instructions that are retrieved from the memory pertain to the finishing element 18 of the printer 16.

In contrast to the printing system recited in Claim 1, the Farrell patent does not disclose that the memory of the system 10 stores specifications relating to an off-line finishing device. Rather, the alternate finishing instructions described at column 5, lines 9-22 pertain only to the finishing element 18 of the printer 16. Nowhere does the Farrell patent suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

As noted in the Office Action, the Farrell patent contemplates that off-line finishing can occur. For instance, at column 4, lines 17-24, it describes an alternate finishing arrangement denoted as "abstract finishing". As illustrated at step 48 in the flowchart of Figure 3, abstract finishing can be employed as an alternative to substitute finishing. In the case of abstract finishing, slip sheets, folders, colored plastics or annotations in the margins of oversized sheets are utilized. These various types of indicators are used to supply a representation of the desired finishing instructions to "make later off equipment or off site finishing *more likely* to agree with the originally intended finishing instructions."

Thus, the Farrell patent discloses that, when it is not possible to carry out the desired finishing instructions with the available finishing capability of the printer, two alternatives are possible. In one alternative, substitute finishing is employed, in which the available capabilities of the printer's finisher are utilized in place of the desired finishing. In the other alternative, suitable indicators are employed to facilitate later off-site finishing. The patent does not disclose, however, that these indicators are generated with knowledge of the specifications of a particular off-site

finisher. Rather, as the patent indicates, these indications are provided in the abstract, with the objective that the finishing is "more likely" to agree with the original desired finishing.

To the extent that the system of the Farrell patent distinguishes between finishing specifics that are to be performed by the on-line printing system and those to be performed off-line, it does so only on the basis of the capabilities of the on-line system. In other words, the finishing specifics that are designated to be done off-line are those which are not capable of being accomplished by the on-line system. In making this designation, however, the system of the Farrell patent does not have knowledge whether the off-line system is, in fact, capable of performing those finishing specifics. This is because it does not disclose that any information regarding a particular off-line finisher is stored in the system.

In contrast, Claim 1 recites that the printing system includes a memory that stores specifications of the on-line printer "and of the off-line finishing device", as well as information regarding options installed thereon. Based upon this stored knowledge of the capabilities of both the on-line printer and the off-line finishing device, the sorter is able to separate the finishing specifics into those which are to be performed by the on-line printer and those to be performed by the off-line finishing device. Consequently, if the off-line finishing device does not have a particular capability, a finishing specific associated with that capability will not be assigned to it.

In summary, the printing system recited in Claim 1 delineates between finishing specifics that are to be performed by an on-line printer and those to be performed by an off-line finishing device, based upon stored information about both the on-line printer and the off-line finishing device. In contrast, the system of the

Farrell patent only bases its decisions upon knowledge of the capabilities of the on-line printing system, including its associated finishing element. It does not store knowledge about the off-line device which may be employed to finish the job. It is for this reason that the patent indicates that offsite finishing is only "likely" to agree with the original intended finishing instructions.

In view of the foregoing, it is respectfully submitted that the Farrell patent does not disclose the subject matter for which it is being relied upon in the rejection of the claim, namely a printing system that stores information about both an on-line printer and an off-line finishing device, and which assigns finishing specifics to these respective devices based upon such stored information. While the Trovinger patent discloses an off-line finishing device, there is no showing in the Office Action that it discloses the subject matter that is missing from the Farrell patent. Consequently, any logical combination of the teachings of the Farrell and Trovinger patents, to provide a printing system having both an on-line printer with a finishing element, and an off-line finishing device, would not result in the subject matter of claim 1. Reconsideration and withdrawal of the rejection of Claim 1 is therefore respectfully requested.

It is respectfully submitted that pending independent claims 4, 7, 10 and 13 also recite this distinguishing subject matter. For the same reasons, therefore, the Farrell and Trovinger patents do not suggest the subject matter of any of these claims to a person of ordinary skill in the art, even when they are considered in combination. Nor does the Jeyachandran patent overcome this difference.

Claim 16 recites a print server to be used in a printing system that includes a client, the print server, a printer on which at least one finishing option is installed, and

a finishing device that is separately provided from the printer. The print server includes a first memory section that stores information on the specifications of the printer, the finisher, and the at least one finishing option installed on the printer. The print server also includes a control section that separates the finishing specifics included in a job ticket into a first group of finishing specifics to be performed by the finishing option installed on the printer and a second group of finishing specifics to be performed by the finishing device, based on the stored information about the specifications of the printer, the finishing device, and the finishing option installed on the printer.

Claim 24 recites a print server that includes, among other elements, a memory for storing specifications of an on-line printer and of a finishing device and information on respective finishing features of each, and a sorter for separating the finishing specifics included in a job ticket into those to be performed by the on-line printer and those to be performed by the finishing device, based on the information regarding the specifications and installed options that is stored in the memory. Claim 22 recites a printing system that includes such a server.

Claim 26 recites a printing system having a server that includes, among other elements, a sorter for separating the finishing specifics included in a job ticket into those to be performed by an on-line printer and those to be performed by a finishing device, based on information regarding first and second finishing features of the on-line printer and the finishing device, respectively. Claim 25 recites a computer-readable medium containing a computer program that performs the corresponding separating operation, based upon such information.

For reasons similar to those presented previously, it is respectfully submitted that each of these claims is patentably distinct from the teachings of the Farrell and Trovinger patents, whether considered individually or in combination. Each claim recites that the separation of finishing specifics between those to be performed by the printer and those to be performed by the finishing device is based upon information pertaining to both a finishing option (or feature) available on the printer and the specifications (or finishing feature) of the finishing device. As noted above, the Farrell patent only discloses that information pertaining to the available finishing options on the printer is stored, and used to determine how the print job is to be finished. There is no storage of information pertaining to the features of a finishing device that is distinct from the printer, let alone use of such information to determine which finishing operations are to be performed by the printer and which are to be performed by a distinct finishing device.

Other distinguishing features of the invention are set forth in the dependent claims. In view of the fundamental difference identified above, a further discussion of these additional distinctions is believed to be unnecessary at this time.

For the foregoing reasons, it is respectfully submitted that all pending claims are patentably distinct from the prior art of record. Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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